



Atty. Dkt. No.: WG0091

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michael D. Vrska, Jr.

Title: PUTTER HAVING AN INSERT
OF VARIABLE THICKNESS

Appl. No.: 09/945,485

Filing Date: August 30, 2001

Examiner: Duong, Thanh P.

Art Unit: 1764

Mail Stop: APPEAL BRIEF – PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

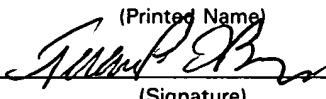
CERTIFICATE OF EXPRESS MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service's "Express Mail Post Office To Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and is addressed to: Commissioner for Patents, P.O. Box.

EU 934896405 US May 6, 2004
(Express Mail Label Number) (Date of Deposit)

Terence P. O'Brien

(Printed Name)



(Signature)

ATTENTION: Board of Patent Appeals and Interferences

Honorable Sir:

RECEIVED
MAY 20 2004
TECHNOLOGY CENTER R3100

APPEAL BRIEF

APPEAL BRIEF

This brief contains in the following sections under the headings and in the order set forth below as required by 37 C.F.R. §1.192(c):

I. REAL PARTY IN INTEREST

II. RELATED APPEALS AND INTERFERENCES

III. STATUS OF CLAIMS

IV. STATUS OF AMENDMENTS

V. SUMMARY OF THE INVENTION

VI. ISSUES

VII. GROUPING OF CLAIMS

VIII. ARGUMENTS – REJECTIONS UNDER 35 U.S.C. §103(a)

- 1. CLAIMS 1-7 AND 9-35 FULLY COMPLY WITH THE REQUIREMENTS OF 35 U.S.C. § 112, FIRST PARAGRAPH.**
- 2. CLAIMS 1-7 AND 9-35 FULLY COMPLY WITH THE REQUIREMENTS OF 35 U.S.C. § 112, SECOND PARAGRAPH.**
- 3. CLAIMS 1, 2, 4-7, 9-16 AND 18-25 ARE NOT OBVIOUS IN VIEW OF DEWANJEE (U.S. PAT. NO. 6,273,831) AND IN FURTHER VIEW OF ROHRER (U.S. PAT. NO. 6,431,997).**
- 4. CLAIMS 3, 17 AND 27-35 ARE NOT OBVIOUS IN VIEW OF DEWANJEE AND IN FURTHER VIEW OF GRIM, JR. ET AL. (U.S. PAT. NO. 5,551,694).**

5. CONCLUSION

IX. APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

The final page of Section VIII bears the signature of Applicant's (Appellant's) attorney.

I. REAL PARTY IN INTEREST (37 C.F.R. §1.192(c)(1))

Wilson Sporting Goods Co. is the real party of interest by virtue of an assignment of the above-referenced application from the inventor, Michael D. Vrska, Jr. to Wilson Sporting Goods Co. The Assignment was recorded in the U.S. Patent and Trademark Office at Reel 012164, Frame 0028. Wilson Sporting Goods Co. is a Delaware Corporation having a principal place of business at 8700 W. Bryn Mawr Avenue, Chicago, Illinois 60631.

II. RELATED APPEALS AND INTERFERENCES (37 C.F.R. §1.192(c)(2))

There are no known appeals or interferences related to this application.

III. STATUS OF CLAIMS (37 C.F.R. §1.192(c)(3))

a. TOTAL NUMBER OF CLAIMS IN THIS APPLICATION

Claims in this application: 34

b. STATUS OF ALL CLAIMS

Claims 1-7 and 9-35 are rejected.

Claim 8 was previously canceled without prejudice.

c. CLAIMS ON APPEAL

The claims on appeal are claims 1-7 and 9-35.

IV. STATUS OF AMENDMENT (37 C.F.R. §1.192(c)(4))

No amendment has been filed subsequent to the final rejection of claims 1-7 and 9-35.

V. SUMMARY OF THE INVENTION (37 C.F.R. §1.192(c)(5))

Briefly stated, the present invention is directed to a golf putter including a putter head 12, a shaft 14 and a grip 16. *See page 6, ¶ 0023.* The putter head 12 includes a main body 18 and an insert 20. *See page 6, ¶ 0023.* The main body is formed of a high strength, durable material, preferably a stainless steel or other metal. *See page 7, ¶ 0023.* The main body 18 includes a toe portion 26, a heel portion 28, a sole portion 30, a hosel 32 and a front wall 34. *See page 7, ¶ 0026.* The sole portion 30 rearwardly extends from the front wall 34 and outwardly extends from the heel portion 28 to the toe portion 26. *See page 7, ¶ 0026.* The front wall 34 is a generally planar, generally vertical member extending from the heel portion 28 to the toe portion 26. *See page 8, ¶ 0027.* The front wall 34 includes a front strike face 36, a rear portion 38, an upper layer 40 and a lower layer 42. *See page 8, ¶ 0027.* Preferably, the strike face 36 and other locations on the main body 18 also include alphanumeric indicia and/or graphical images representative of product characteristics, source of the putter and other related information. *See page 8, ¶ 0027.*

The rear portion 38, and the upper and lower layers 40 and 42 define a recess 44 rearwardly extending from the front strike face 36 into the front wall 34. *See page 8, ¶ 0028.* The recess 44 preferably extends over a central region of the front

wall 34 from the heel portion 28 to the toe portion 26, and is configured to receive the insert 20. *See page 8, ¶ 0028.* Referring to FIG. 4, the thickness of the rear portion 38 varies at various points along the recess 44 to provide the recess 44 with a variable rearward depth. *See page 8, ¶ 0028.* Preferably, the rearward depth of the recess 44 is greatest along a vertical plane 46 centrally located along the front wall 34 and extending substantially perpendicular to the strike face 36. *See page 8, ¶ 0028.* The rearward depth of the recess 44 gradually and uniformly decreases further away from the plane 46 toward the toe and heel portions 26 and 28 to form a uniform taper from the plane 46 toward each of the toe and heel portions 26 and 28. *See page 8, ¶ 0028.*

The insert 20 is an elongate member coupled to the main body 18 at the recess 44. *See page 9, ¶ 0029.* The insert 20 includes the front surface 48, a rear surface 49, a top surface and a bottom surface. *See page 9, ¶ 0029.* The insert 20 takes the form of the recess 44. *See page 9, ¶ 0029.* Preferably, the material of the insert 20 substantially fills the recess 44 such that, upon curing, a front surface 48 of the insert 20 is generally flush, or coplanar, with the strike face 36 of the front wall 34. *See page 9, ¶ 0029.* Preferably, the front wall 34 substantially covers the rear surface 49 and the top and bottom surfaces of the insert 20. *See page 9, ¶ 0029.* The castable formation of the insert 20 to the body 18 provides an optimum connection between the insert 20 and the body 18 without the use of an adhesive or an adhesive agent. *See page 9, ¶ 0029.*

The insert 20 is made of a lightweight material, preferably a castable urethane that is softer than the material of the body 18 of the putter head 12. *See page 10, ¶ 0031.* The material of the insert 20 preferably has a durometer of between 40 and 65 on a Shore A hardness scale. *See page 10, ¶ 0031.* In a particularly preferred embodiment, the material of the insert 20 has a durometer of between 45 and 55 on a Shore A hardness scale. *See page 10, ¶ 0031.* In another alternative preferred embodiment, the insert 20 is made of a translucent material. *See page 10, ¶ 0031.*

Additionally, the material of the insert 20 preferably includes a colorant enabling the insert 20 to be formed in a variety of single colors or multi-color combinations. *See* page 10, ¶ 0031.

The sole portion 30 of the putter head 12 includes a centrally positioned, downwardly extending cavity 50 and a sight line 52. *See* page 12, ¶ 0034. The cavity 50 preferably extends across the entire depth of the sole portion 30. *See* page 12, ¶ 0034. The sight line 52 is preferably a groove downwardly extending into the sole portion 30. *See* page 12, ¶ 0034. The sight line 52 extends across the sole portion 30 preferably along the plane 46. *See* page 12, ¶ 0035. The putter head 12 further includes an elongate sole slot 56 extending through the putter head 12 from the heel portion 28 to the toe portion 26, and between the front wall 34 and the sole portion 30. *See* page 13, ¶ 0037.

The present invention includes several preferred embodiments, wherein the recess and the insert have corresponding shapes that result in the insert having a variable rearward depth. *See* FIGS. 2-4 and 8-12. For example, the shapes can be polygonal, triangular, trapezoidal, arcuate and combinations thereof. *See* FIGS. 2-4 and 8-12.

A putter head 412 includes a main body 418 having a front strike face 436 and an insert 420. *See* page 15, ¶ 0041. The putter head 412 is substantially similar to the putter head 12 except that the recess 444 within the main body 418 substantially extends across the entire strike face 436 of the main body 418. *See* page 15, ¶ 0041. The insert 420 substantially fills the recess 444 such that a front surface 448 of the insert 420 substantially extends across the strike face 436 of the putter head 412. *See* page 15, ¶ 0041. In alternative preferred embodiments, the recess of the putter head and the insert are configured to extend across the front strike face of the

putter head by an amount different from the putter head 12 and the putter head 412.

See page 15, ¶ 0041.

VI. ISSUES (37 C.F.R. §1.192(c)(6))

(1) The first issue presented in this appeal is the rejection of claims 1-7 and 9-35 as failing to comply with the written description requirement of 35 U.S.C. § 112, first paragraph.

(2) The second issue presented in this appeal is the rejection of claims 1-7 and 9-35 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention under 35 U.S.C. § 112, second paragraph,.

(3) The third issue presented in this appeal is the rejection of claims 1, 2, 4-7, 9-16 and 18-25 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,273,831 to Dewanjee in view of United States Patent No. 6,431,997 to Rohrer.

(4) The fourth issue presented in this appeal is the rejection of claims 3, 17 and 27-35 under 35 U.S.C. § 103(a) as being unpatentable over Dewanjee (6,273,831) in view of United States Patent No. 5,551,694 to Grim, Jr. et al.

VII. GROUPING OF CLAIMS (37 C.F.R. §1.192(c)(7))

Claims 1-7 and 9-35 are rejected under 35 U.S.C. § 112, first paragraph.

All of the claims of this group stand together.

Claims 1-7 and 9-35 are rejected under 35 U.S.C. § 112, second paragraph. All of the claims of this group stand together.

Claims 1, 2, 4-7, 9-16 and 18-25 are rejected under 35 U.S.C. § 103(a) over Dewanjee (6,273,831) in view of Rohrer (6,431,997). All of the claims of this group do not stand or fall together.

Claims 3, 17 and 27-35 are rejected under 35 U.S.C. § 103(a) over Dewanjee (6,273,831) in view of Grim, Jr. et al. (5,551,694). All of the claims of this group do not stand or fall together.

VIII. ARGUMENTS

1. CLAIMS 1-7 AND 9-35 FULLY COMPLY WITH THE REQUIREMENTS OF 35 U.S.C. § 112, FIRST PARAGRAPH.

In a final Office Action dated February 11, 2004, Examiner Duong rejected claims 1-7 and 9-35 under 35 U.S.C. § 112, first paragraph. In particular, Examiner Duong, rejected claims 1-7 and 9-35 because the following limitation of independent claims 1, 15 and 27 below failed to comply with the written description requirement. Claims 2-7 and 9-14 depend from, and include all the limitations of, claim 1. Claims 16-26 depend from, and include all the limitations of, claim 15.

Claims 28-35 depend from, and include all the limitations of, claim 27. The limitation states:

the insert including a center portion having a first rearward depth, the putter head having a second rearward depth measured from the front strike face of the front wall to the rearmost surface of the sole portion, the first depth being less than fifty percent of the second depth.

Claims 1, 15 and 27 of U.S. Appl. Ser. No. 09/945,485.

Contrary to Examiner Duong's assertions, the specification and the drawings of the present invention provides a clear, enabling and complete description of the present invention. Significantly, the drawings alone can provide the "written description of the invention" required by § 112, first paragraph. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1564 (Fed. Cir. 1991).

The present invention describes several preferred embodiments of a putter having a putter head including a recess with variable rearward depth and an insert substantially filling the recess. "The variable thickness, or variable rearward depth, of the insert 20 enables the putter head 12 to substantially reduce or eliminate the distance loss resulting from inaccurate or off-center contact of the putter head 12 with a ball." Pg. 11, ¶ 0032 of U.S. Appl. Ser. No. 09/945,485.

In support of the subject limitation, the specification describes the insert, the recess defined in the putter head for receiving the insert, and the putter head itself.

The excerpts listed below from the specification illustrate some of the language from the specification that supports the subject limitation.

- Referring to FIG. 4, the thickness of the rear portion 38 varies at various points along the recess 44 to provide the recess 44 with variable rearward depth. Preferably, the rearward depth of the recess 44 is greatest along a vertical plane 46 centrally located along the front wall and extending substantially perpendicular to the strike face 36. *Pg. 8, ¶ 0028.*
- In a particularly preferred embodiment, the rearward depth or thickness of the insert 20 at the plane 46 is approximately 0.275. *Pg. 8, ¶ 0028.*
- The insert 20 and the recess 44 can also be configured in different sizes. *Pg. 9, ¶ 0028.*
- Preferably, the material of the insert 20 substantially fills the recess 44. *Pg. 9, ¶ 0029.*
- At the intended strikepoint along plane 46, the putter head 12 has the greatest thickness of soft insert material resulting in the largest amount of energy absorption when contacting a ball. *Pg. 11, ¶ 0032.*
- The insert 120 has a maximum, generally uniform depth over a central portion 160 of the insert 120. *Pg. 14, ¶ 0038.*
- The insert 320 has a maximum rearward depth or thickness at a centrally positioned vertical plane 346 extending through the putter head 312 perpendicular to the strike face 336. *Pg. 15, ¶ 0040.*
- The main body 18 includes a toe portion 26, a heel portion 28, a sole portion 30, a hosel 32 and a front wall 34. Referring to FIG. 3, the sole portion 30 rearwardly extends from the front wall 34. *Pg. 7, ¶ 0026.*

Importantly, the drawings of U.S. Appl. Ser. No. 09/945,485 further define and complete the description of the present invention and, in particular, the

subject matter of the subject limitation. In evaluating whether the requirements of § 112 have been satisfied, “it is essential that the court consider what the drawing conveyed to a person of ordinary skill in the art and determine whether the drawing conveyed to that skilled person that the patentee had in fact invented the invention recited in the claims.” *Trilithic, Inc. v. Wavetek U.S., Inc.*, 64 F.Supp.2d 816, 820 (S.D. Ind. 1999) (*citing Vas-Cath Inc. v. Mahurkar*, 935 F.2d at 1565. Here, FIGS. 3, 4, 6, 7, 8, 9 and 10 clearly illustrate the rearward depth of the insert, the rearward depth of the putter head, and the relationship between the two depths. FIGS. 3, 4, 8, 9 and 10 illustrate four separate preferred embodiments of the present invention. In each of these FIGS., it is readily apparent to one of ordinary skill in the art that in each of the preferred embodiments described the rearward depth of the insert along a center portion of the insert is less than fifty percent of the depth of the putter head measured from the front strike face of the front wall to the rearmost surface of the sole portion. For at least these reasons, the rejection of claims 1-7 and 9-35 under 35 U.S.C. § 112, first and second paragraphs should be reversed.

2. CLAIMS 1-7 AND 9-35 FULLY COMPLY WITH THE REQUIREMENTS OF 35 U.S.C. § 112, SECOND PARAGRAPH.

In a final Office Action dated February 11, 2004, Examiner Duong also rejected claims 1-7 and 9-35 under 35 U.S.C. § 112, second paragraph. In particular, Examiner Duong, rejected claims 1-7 and 9-35 because the same limitation of independent claims 1, 15 and 27 (the same limitation listed above) is indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2-7 and 9-14 depend from, and include all the limitations of, claim 1. Claims 16-26 depend from, and include all the limitations of, claim 15. Claims 28-35 depend from, and include all the limitations of, claim 27.

“The requirement of claim definiteness set out in § 112 ¶ 2 assures that claims in a patent are “sufficiently precise to permit a potential competitor to determine whether or not he is infringing.” *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1342 (Fed. Cir. 2003). “The standard of indefiniteness is somewhat high; a claim is not indefinite merely because its scope is not ascertainable from the face of the claims.” *Id.* Rather, a claim is indefinite under § 112 ¶ 2 only if it is “insolubly ambiguous, and no narrowing construction can properly be adopted.” *Id.* (quoting, *Exxon Research & Eng’g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001). Further, a claim is indefinite if, when read in light of the specification, it does not reasonably apprise those skilled in the art of the scope of the invention. *Id.*; *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1378 (Fed. Cir. 2000).

Here, as stated above with respect to the rejection based upon 35 U.S.C. § 112, first paragraph, the specification of the present application includes substantial disclosure relating to the insert, the recess in the putter head and the putter head itself. The specification describes in detail the configuration of several preferred embodiments of the present invention. Significantly, the drawings of the present invention further

clearly discloses the claimed invention. Here, FIGS. 3, 4, 6, 7, 8, 9 and 10 clearly illustrate the rearward depth of the insert, the rearward depth of the putter head, and the relationship between the two depths. FIGS. 3, 4, 8, 9 and 10 illustrate four separate preferred embodiments of the present invention. In each of these FIGS., it is readily apparent to one of ordinary skill in the art that in each of the preferred embodiments described the rearward depth of the insert along a center portion of the insert is less than fifty percent of the depth of the putter head measured from the front strike face of the front wall to the rearmost surface of the sole portion.

The rejected claims, including the subject limitation, are definite and accurate. The subject claim limitation is unambiguous. The claims, when read in light of the specification, thoroughly apprise those skilled in the art of the scope of the invention. For at least these reasons, the rejection of claims 1-7 and 9-35 under 35 U.S.C. § 112, first and second paragraphs should be reversed.

3. CLAIMS 1, 2, 4-7, 9-16 AND 18-25 ARE NOT OBVIOUS IN VIEW OF DEWANJEE (U.S. PAT. NO. 6,273,831) AND IN FURTHER VIEW OF ROHRER (U.S. PAT. NO. 6,431,997).

A. Not all of the claims of this group stand or fall together on this issue.

Claims 1 and 15 are independent claims. Claims 2, 4-7 and 9-14 depend from, and include all the limitations of, claim 1. Therefore, claims 1, 2, 4-7 and 9-14 comprise one subgroup that stands or falls together on this issue. Claims 16 and 18-25

depend from, and include all the limitations of, claim 15. Claims 15, 16 and 18-25 comprise a second subgroup that stands or falls on this issue.

*B. The Examiner has not shown *prima facie* obviousness.*

Examiner Duong did not show that claims 1, 2, 4-7, 9-16 and 18-25 are obvious. Dewanjee and Rohrer, when taken in any permissible combination, do not disclose, teach, or suggest the putter head of either claim 1 or claim 15. In particular, neither Dewanjee nor Rohrer, alone or in combination, disclose, teach or suggest a putter head including a single, one-piece insert and a generally vertically extending front wall having a rear portion and including a recess, wherein the rear portion of the front wall is formed with variable thickness to provide the recess with a variable rearward depth.

For at least these reasons, Dewanjee and Rohrer do not support a *prima facie* case that the invention would be obvious. More particularly, there was no suggestion or motivation to modify the prior art references or to combine reference teachings. In the present case, the Examiner has, once again, not met the burden of showing some suggestion of the desirability of doing what the inventor alone has done. No combination of prior art relied on by the Examiner teaches, suggests or discloses the important limitations set forth in Applicant's claims.

C. *Dewanjee does not teach, suggest or disclose the present invention.*

Dewanjee does not disclose, teach or suggest the present invention. The present invention of claims 1, 2, 4-7 and 9-14 relates to a putter head including a toe portion, a heel portion, a generally vertically extending wall, a sole portion, and a single, one-piece insert. The wall has a front strike face, a rear portion, an upper layer, and a lower layer. The upper layer, the lower layer and the rear portion each extend from the heel portion to the toe portion to define a recess that rearwardly extends into the wall from the strike face. The rear portion of the wall is formed with variable thickness thereby providing the recess with a variable rearward depth. The sole portion rearwardly extends from a lower region of the wall and has a rearmost surface. The insert substantially fills the recess and is connected to the wall. The insert has a front facing surface that is generally exposed and substantially coplaner with the front strike face. The insert includes a center portion having a first rearward depth. The putter head has a second rearward depth measured from the front strike face of the front wall to the rearmost surface of the sole portion. The first depth is less than fifty percent of the second depth.

Dewanjee also does not disclose, teach or suggest the present invention of claims 15, 16 and 18-25. Independent claim 15 of the present invention is directed toward a putter head including a generally vertically extending wall, a sole portion and only one insert. The generally vertically extending wall has a front strike face and a rear surface. The wall has an insert region at the strike face defining a rearwardly

extending recess of varying rearward depth. The sole portion rearwardly extends from a lower region of the wall and has a rearmost surface. The insert is castably formed in the recess of the insert region. The insert has a front surface and a variable rearward depth to substantially fill the recess. The insert contacts the insert region of the wall. Substantially the entire surface area of the front surface of the insert is substantially coplanar with the front strike face. The insert includes a center portion having a first rearward depth. The putter head has a second rearward depth measured from the front strike face of the front wall to the rearmost surface of the sole portion. The first depth is less than fifty percent of the second depth.

In contrast, Dewanjee is directed toward a golf club head with a polymer insert of uniform rearward depth. The club head includes a body with a recess of uniform depth defined therein. Specifically, the recess is defined by a recess face wall and a recess edge wall of the body of the club head. The recess face wall is substantially parallel with the exposed striking surface of the insert, and the recess edge wall is substantially perpendicular to the recess face wall. The recess face wall necessarily defines the uniform depth or thickness of the insert. The sheet of material used to form the insert has a uniform thickness. The uniform thickness of the insert can be varied only uniformly and as a whole from one club head to another club head to change the feel of one club head to another club head. Dewanjee does not teach, suggest or disclose a club head having a recess with variable rearward depth from the striking face

of the club head. Dewanjee also does not teach, suggest or disclose a single insert for a clubhead that includes variable thickness or rearward depth on a single club head.

Dewanjee very specifically and deliberately teaches and emphasizes a club head including a body having a recess of only a uniform depth, and a corresponding insert of only a uniform depth or thickness. Dewanjee does teach variations in several different characteristics of the insert, including the material of the insert, and the size and shape of the insert when viewed from the striking surface of the club head. While disclosing and teaching these numerous variations in other design features of the insert, Dewanjee very directly and clearly teaches an insert having only a uniform depth or thickness. Dewanjee is completely devoid of any teaching, suggestion or motivation indicating that the thickness or depth of a single insert can be varied.

C. Rohrer, U.S. Pat. No. 6,431,997, does not teach, suggest or disclose the present invention.

Rohrer also does not disclose, teach or suggest the present invention. Rohrer discloses several embodiments of club heads intended to be configured to correct distance loss due to mishits. None of the embodiments disclosed or taught by Rohrer teach, suggest or disclose the combination of elements and limitations of claim 1. Most of the embodiments disclosed by Rohrer, including the embodiments of FIGS. 5-8 and 11-15, include a plurality of inserts connected to the clubhead body, and not a single, one-piece insert. The remaining embodiments, including the embodiments of FIGS. 9A, 9B, 10A, and 10B, do not include an insert having a front facing surface, wherein

generally the entire surface area of the front facing surface is exposed. Further, the remaining embodiments do not include an insert having a front facing surface that is substantially coplanar with the strike face.

None of the embodiments of Rohrer disclose a single insert substantially filling a recess of variable rearward depth formed into the putter head wherein the recess includes a central portion having a first rearward depth and the putter head has a second rearward depth with the first depth being less than fifty percent of the second depth. All of Rohrer's embodiments show multiple piece inserts, inserts that do not substantially fill the recess, and/or an insert with a rearward depth that is significantly greater than fifty percent of the rearward depth of the putter head. The embodiments of Rohrer also do not teach, suggest or disclose a one-piece insert filling a recess having a variable rearward depth formed into a putter head, wherein a central portion of the insert has a first rearward depth, and the putter head has a second rearward depth, and the first rearward depth is less than fifty percent of the second rearward depth.

D. The Examiner's rejection under 35 U.S.C. § 103(a) amounts to impermissible reconstruction.

The Examiner's combining of Dewanjee and Rohrer to conclude obviousness is believed to be impermissible reconstruction, particularly when the references would not be fairly combined by one skilled in the art. Dewanjee specifically avoids a recess formed into the body of the club head, or a single insert, having a variable rearward depth or thickness. Rohrer lists numerous embodiments of

club heads with numerous combinations of inserts, but specifically avoids the use of a single one-piece insert, and also avoids the use of a single insert having a variable thickness or depth that also has an exposed front surface that is substantially coplanar with the front strike face of the club head. None of the teachings or the disclosures of Dewanjee or Rohrer, alone or in combination, disclose, teach or suggest the limitations of claim 1. Any suggestion for combining these references is therefore based solely on the Examiner's impermissible hindsight since there is no connective teaching or suggestion. "When applying 35 U.S.C. 103, ... the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention..." *Hodosh v. Block Drug. Co., Inc.*, 229 USPQ 182, 187 (Fed. Cir. 1986). The mere fact that the references can possibly be combined, does not render the resulting combination obvious unless the cited art also suggests the desirability of that combination. *In re Mills*, 16 USPQ.2d 1430 (Fed. Cir. 1990).

4. CLAIMS 3, 17 AND 27-35 ARE NOT OBVIOUS IN VIEW OF DEWANJEE AND IN FURTHER VIEW OF GRIM, JR. ET AL. (U.S. PAT. NO. 5,551,694).

A. Not all of the claims of this group stand or fall together on this issue.

Claim 3 is a dependent claim that depends from, and includes all the limitations of, independent claim 1, and claim 17 is a dependent claim that depends from, and includes all the limitations of, independent claim 15. Therefore, claims 3 and 17 each stand or fall alone on this issue. Claim 27 is an independent claim. Claims 28-35 are dependent claims that depend from, and include all the limitations of independent claim

27. Therefore, claims 27-35 comprise one subgroup that stands or falls together on this issue.

*B. The Examiner has not shown *prima facie* obviousness.*

Examiner Duong did not show that claims 3, 17 and 27-35 are obvious.

Dewanjee and Grim, Jr. et al., when taken in any permissible combination, do not disclose, teach, or suggest the putter head of either claim 3, claim 17, or claim 27. In particular, neither Dewanjee nor Grim, Jr. et al., alone or in combination, disclose, teach or suggest a putter head including an insert and a generally vertically extending front wall a recess defined therein, wherein the recess is formed with variable thickness and the insert substantially fills the recess thereby also having a variable depth or thickness.

For at least these reasons, Dewanjee and Grim, Jr. et al. do not support a *prima facie* case that the invention would be obvious. More particularly, there was no suggestion or motivation to modify the prior art references or to combine reference teachings. In the present case, the Examiner has, once again, not met the burden of showing some suggestion of the desirability of doing what the inventor alone has done. No combination of prior art relied on by the Examiner teaches, suggests or discloses the important limitations set forth in Applicant's claims.

Further, even if Dewanjee and Grim, Jr. et al. were combined, as the Examiner suggests, neither Dewanjee nor Grim, Jr. et al. teach, suggest or disclose the

combination of elements and limitations of any one of claims 3, 17 and 27-35. In particular, neither Dewanjee nor Grim, Jr. et al. teach, suggest or disclose the limitation of a putter head having a generally vertically extending wall having a front strike face with a rearwardly extending recess defined into the strike face of the wall wherein the recess has varying rearward depth, and wherein an insert substantially fills the recess.

C. Dewanjee does not teach, suggest or disclose the present invention.

Dewanjee does not disclose, teach or suggest the present invention, and, in particular, the present invention of claims 3, 17 and 27-35. Each of claims 3, 17 and 35 include a putter head having a generally vertically extending wall having a front strike face and a sole portion rearwardly extending from the front wall. A recess having variable rearward depth is defined into the strike face of the wall and an insert substantially fills the recess. The sole portion has only one elongate through-sole slot disposed rearward of the insert and substantially parallel to the strike face.

In contrast, Dewanjee is directed toward a golf club head with a polymer insert of uniform rearward depth. The club head includes a body with a recess of uniform depth defined therein. Specifically, the recess is defined by a recess face wall and a recess edge wall of the body of the club head. The recess face wall is substantially parallel with the exposed striking surface of the insert, and the recess edge wall is substantially perpendicular to the recess face wall. The recess face wall defines the

uniform depth or thickness of the insert. The sheet of material used to form the insert has a uniform thickness. The uniform thickness of the insert can be varied only uniformly and as a whole from one club head to another club head to change the feel of one club head to another club head.

Dewanjee very specifically and deliberately teaches and emphasizes a club head including a body having a recess of only a uniform depth, and a corresponding insert of only a uniform depth or thickness. Dewanjee does teach variations in several different characteristics of the insert, including the material of the insert, and the size and shape of the insert when viewed from the striking surface of the club head. While disclosing and teaching these numerous variations in other design features of the insert, Dewanjee very directly and clearly teaches an insert having only a uniform depth or thickness. Dewanjee is completely devoid of any teaching, suggestion or motivation indicating that the thickness or depth of a single insert can be varied.

Dewanjee is also devoid of any teaching, suggestion or disclosure of a through-sole slot formed into a sole portion of the club head.

D. Grim, Jr. et al. does not teach, suggest or disclose the present invention. Grim, Jr. et al. does not disclose, teach or suggest the present invention, and, in particular, the present invention of claims 3, 17 and 27-35. Each of claims 3, 17 and 35 include a putter head having a generally vertically extending wall having a front strike face and a sole portion rearwardly extending from the front wall. A recess

having variable rearward depth is defined into the strike face of the wall and an insert substantially fills the recess. The sole portion has only one elongate through-sole slot disposed rearward of the insert and substantially parallel to the strike face.

Grim, Jr. et al. discloses a golf putter having a plurality of sound-generating tines formed into the club head. Grim, Jr. et al. does not disclose only one through-sole slot. Grim, Jr. et al. does not disclose a recess formed into a front wall of a club head for receiving an insert, let alone a recess or insert having variable rearward depth.

E. The Examiner's rejection under 35 U.S.C. § 103(a) is incorrect because the Examiner's proposed combination would not include all the elements of any of claims 3, 17 and 27-35.

The Examiner's combining of Dewanjee and Grim, Jr. et al. to conclude obviousness fails to establish *prima facie* obviousness because even if these two references were combined, the proposed combination would not include all the limitations of any one of claims 3, 17 and 27-35. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). A combination of Dewanjee and Grim, Jr. et al. would not include the limitation of a putter head having a generally vertically extending wall having a front strike face with a rearwardly extending recess defined into the strike face of the wall wherein the recess has varying rearward depth,

and wherein an insert substantially fills the recess, and wherein a sole portion of putter head includes only one through-sole slot.

5. CONCLUSION

The Examiner has asserted rejections under 35 U.S.C. § 112, first and second paragraphs, and 35 U.S.C. § 103(a). Regarding the rejection under 35 U.S.C. § 112, first paragraph, the specification and the drawings of the present application describe the subject matter defined by each of the rejected claims, and, in particular, the limitation specifically cited by the Examiner. The specification and drawings of the present invention enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims. Moreover, the specification and drawings of the present invention also include the best mode of carrying out the invention contemplated by the inventor at the time of filing the application.

Regarding the rejection under 35 U.S.C. § 112, second paragraph, the specification and the drawings of the present application particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the specification and drawings particularly point out and distinctly claim the limitation of independent claims 1, 15 and 27 referred to by the Examiner.

For the Examiners rejection of claims 1, 2, 4-7, 9-16 and 18-25 under 35 U.S.C. § 103(a), the Examiner has not established a *prima facie* case for an obviousness rejection. Despite the Examiner's assertions, the references cited by the

Examiner, when taken in any permissible combination, do not disclose, teach or suggest a putter head including a single, one-piece insert and a generally vertically extending front wall having a rear portion and including a recess, wherein the rear portion of the front wall is formed with variable thickness to provide the recess with a variable rearward depth.

For the Examiners rejection of claims 3, 17and 27-35 under 35 U.S.C. § 103(a), the Examiner has not established a *prima facie* case for an obviousness rejection. Despite the Examiner's assertions, the references cited by the Examiner, when taken in any permissible combination, do not include all the limitations of any one of the claims3, 17 and 27-35. For example, a combination of Dewanjee and Grim, Jr. et al. would not include the limitation of a putter head having a generally vertically extending wall having a front strike face with a rearwardly extending recess defined into the strike face of the wall wherein the recess has varying rearward depth, and wherein an insert substantially fills the recess, and wherein a sole portion of putter head includes only one through-sole slot.

Accordingly, Applicant respectfully submits that the final rejection of claims 1-7 and 9-35 must be reversed, and these claims allowed.

Pursuant to 37 C.F.R. § 1.17(c), Applicant authorizes the Commissioner to charge Deposit Account No. 501959 in the amount of \$330.00 to cover the filing fee for filing a brief in support of appeal. Commissioner is also hereby authorized to

charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 501959.

Respectfully submitted,

Date 6 May 2004
Wilson Sporting Goods Co.
8700 W. Bryn Mawr Avenue
Chicago, IL 60631

By Terence P. O'Brien
Terence P. O'Brien
Attorney for Applicants
Registration No. 43,840

Telephone: (847) 472-6104
(773) 714-6498

Facsimile: (773) 714-4557

IX. APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

1 1. A putter head comprising:
2 a toe portion;
3 a heel portion;
4 a generally vertically extending wall, the wall having a front strike face, a rear
5 portion, an upper layer, and a lower layer, the upper layer, the lower layer and the rear
6 portion each extending from the heel portion to the toe portion to define a recess rearwardly
7 extending into the wall from the strike face, the rear portion of the wall being formed with
8 variable thickness thereby providing the recess with a variable rearward depth;
9 a sole portion rearwardly extending from a lower region of the wall, the sole
10 portion having a rearmost surface; and
11 a single, one-piece insert substantially filling the recess and connected to the
12 wall, the insert having a front facing surface, a top surface, a bottom surface and a rear
13 surface, generally the entire surface area of the front facing surface of the insert being
14 exposed, the top and bottom surfaces being substantially covered by the wall, the front facing
15 surface of the insert being substantially coplanar with the front strike face, the insert including
16 a center portion having a first rearward depth, the putter head having a second rearward depth
17 measured from the front strike face of the front wall to the rearmost surface of the sole portion,
18 the first depth being less than fifty percent of the second depth.

1 2. The putter head of claim 1, wherein the sole portion has an upper surface, and
2 wherein the upper surface has a sight line positioned substantially perpendicular to the strike
3 face.

1 3. The putter head of claim 1, wherein the sole portion has an elongate through-sole
2 slot disposed rearward of the insert and generally parallel to the strike face.

1 4. The putter head of claim 1, wherein the wall includes an upper rear edge generally
2 extending from the heel portion to the toe portion, and wherein the upper rear edge is
3 substantially parallel with the strike face to provide a top alignment line.

1 5. The putter head of claim 1, wherein the insert is a lightweight material selected
2 from the group consisting of a urethane, an epoxy resin, a thermoplastic, a thermoset material,
3 an elastomer, and combinations thereof.

1 6. The putter head of claim 1, wherein the insert is made of a translucent material.

1 7. The putter head of claim 1, wherein the insert is formed in a shape selected from
2 the group consisting of trapezoidal, triangular, polygonal, semi-circular, semi-elliptical, and
3 combinations thereof.

Claim 8 is previously cancelled without prejudice.

1 9. The putter head of claim 1, wherein the recess extends substantially across the
2 entire width of the strike face.

1 10. The putter head of claim 1, wherein the insert is castably formed to the wall
2 without the use of an adhesive.

1 11. The putter head of claim 1, wherein the strike surface has an intended strike
2 region, and wherein the exposed front facing surface extends across the intended strike region
3 of the strike face.

1 12. The putter head of claim 1, wherein the insert is formed of a material having a
2 durometer of between 40 and 65 on a Shore A hardness scale.

1 13. The putter head of claim 1, wherein the insert is formed of a material having a
2 durometer of between 45 and 55 on a Shore A hardness scale.

1 14. The putter head of claim 1, wherein the center portion of the insert is positioned
2 between a toe end portion and a heel end portion, wherein the toe and heel portions of the
3 insert have third and fourth rearward depths, respectively, and wherein the first rearward depth
4 of the center portion is greater than either of the third and fourth rearward depths.

1 15. A putter head comprising:
2 a generally vertically extending wall having a front strike face and a rear
3 surface, the wall having an insert region at the strike face defining a rearwardly extending
4 recess of varying rearward depth;
5 a sole portion rearwardly extending from a lower region of the wall, the sole
6 portion having a rearmost surface; and

7 only one insert castably formed in the recess of the insert region, the insert
8 having a front facing surface and a variable rearward depth to substantially fill the recess, the
9 insert contacting the insert region of the wall, substantially the entire surface area of the front
10 facing surface of the insert being substantially coplanar with the front strike face, the insert
11 including a center portion having a first rearward depth, the putter head having a second
12 rearward depth measured from the front strike face of the front wall to the rearmost surface of
13 the sole portion, the first depth being less than fifty percent of the second depth.

1 16. The putter head of claim 15, wherein the sole portion has an upper surface, and
2 wherein the upper surface has a sight line positioned substantially perpendicular to the strike
3 face.

1 17. The putter head of claim 15, wherein the sole portion has an elongate through-
2 sole slot disposed rearward of the insert and generally parallel to the strike face.

1 18. The putter head of claim 15, wherein the wall includes an upper rear edge
2 generally extending from the heel portion to the toe portion, and wherein the upper rear edge is
3 substantially parallel with the strike face to provide a top alignment line.

1 19. The putter head of claim 15, wherein the insert is a lightweight material selected
2 from the group consisting of a urethane, an epoxy resin, a thermoplastic, a thermoset material,
3 an elastomer, and combinations thereof.

1 20. The putter head of claim 15, wherein the insert is made of a translucent
2 material.

1 21. The putter head of claim 15, wherein the insert is formed in a shape selected
2 from the group consisting of trapezoidal, triangular, polygonal, semi-circular, semi-elliptical,
3 and combinations thereof.

1 22. The putter head of claim 15, wherein the recess is defined in a central region of
2 the strike face, and wherein the exposed front facing surface of the insert extends across the
3 central region of the strike face.

1 23. The putter head of claim 15, wherein the recess extends substantially across the
2 entire width of the strike face, and wherein the exposed front facing surface of the insert is
3 generally coplanar with the strike face.

1 24. The putter head of claim 15, wherein the insert is formed of a material having a
2 durometer of between 40 and 65 on a Shore A hardness scale.

1 25. The putter head of claim 15, wherein the insert is formed of a material having a
2 durometer of between 45 and 55 on a Shore A hardness scale.

1 26. The putter head of claim 15, wherein the center portion of the insert is
2 positioned between a toe end portion and a heel end portion, wherein the toe and heel portions
3 of the insert have third and fourth rearward depths, respectively, and wherein the first

4 rearward depth of the center portion is greater than either of the third and fourth rearward
5 depths.

1 27. A putter head comprising:
2 a toe portion;
3 a heel portion;
4 a generally vertically extending wall extending from the toe portion to the heel
5 portion, the wall having a front strike face and a rear surface;
6 a rearwardly extending recess defined into the strike face of the wall, the recess
7 having varying rearward depth;
8 an insert formed of a first material, the insert substantially filling the recess and
9 connected to the wall; and
10 a sole portion rearwardly extending from a lower portion of the wall, the sole
11 portion having a rearmost surface, the portion having only one elongate through-sole slot, the
12 through-sole slot disposed rearward of the insert and substantially parallel to the strike face,
13 the insert including a center portion having a first rearward depth, the putter head having a
14 second rearward depth measured from the front strike face of the front wall to the rearmost
15 surface of the sole portion, the first depth being less than fifty percent of the second depth.

1 28. The putter head of claim 27, wherein the sole portion has an upper surface, and
2 wherein the upper surface has a sight line positioned substantially perpendicular to the strike
3 face.

1 29. The putter head of claim 27, wherein the wall includes an upper rear edge
2 generally extending from the heel portion to the toe portion, and wherein the upper rear edge is
3 substantially parallel with the strike face to provide a top alignment line.

1 30. The putter head of claim 27, wherein the first material of the insert is a
2 lightweight material selected from the group consisting of a urethane, an epoxy resin, a
3 thermoplastic, a thermoset material, an elastomer, and combinations thereof.

1 31. The putter head of claim 27, wherein the insert is formed in a shape selected
2 from the group consisting of trapezoidal, triangular, polygonal, semi-circular, semi-elliptical,
3 and combinations thereof.

1 32. The putter head of claim 27, wherein the recess extends substantially across the
2 entire width of the strike face, and wherein the exposed front surface of the insert is generally
3 coplanar with the strike face.

1 33. The putter head of claim 27, wherein the insert is castably formed to the wall
2 without the use of an adhesive.

1 34. The putter head of claim 27, wherein the insert is formed of a material having a
2 durometer of between 40 and 65 on a Shore A hardness scale.

1 35. The putter head of claim 27, wherein the insert is formed of a material having a
2 durometer of between 45 and 55 on a Shore A hardness scale.
